

REMARKS/ARGUMENT

Claims 20-22, 28-29, and 32-45 are pending in this case. Claims 1-19 and 30-31 have been cancelled in view of the prior Restriction Requirement and claims 23-27 have been cancelled without prejudice. Claims 20 and 36 have been amended to advance prosecution of the subject application. Applicants respectfully request that the subject application be reconsidered in view of the above claim amendments and the following remarks.

Claims 20-22, 28, 29 and 32-35 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sanders (US 5,290,289). This rejection is respectfully traversed.

Independent claim 20 recites a method of correcting spinal deformities, in which "the correction force [is] generated by a superelastic material at body temperature without using external heating source," and "the superelastic material [has] a transition temperature within the range of body temperature." The cited portions of Sanders do not teach the above claim features.

The Office action concedes that Sanders does not disclose the correction force being generated at body temperature (see, page 4 of Office action), as is the correction force recited in independent claim 20. Indeed, the correction forces in Sanders are generated post-operatively through external heating (see col. 7, ll. 37-60), which is beyond the range of body temperature. Therefore, independent claim 20 is not taught by Sanders. Accordingly, the subject rejection is believed to have been overcome.

In addition, the cited portions of Sanders do not teach that "the correction force [is] generated by a superelastic material ... having a transition temperature within the range of body temperature," as is recited in independent claim 20. In Sanders, a transformation temperature in a 10°C range of normal body temperature is selected for

rod construction (see, col. 4, ll. 16-17). Sanders however does not teach a transition temperature within the range of body temperature as recited in independent claim 20. Therefore, independent claim 20 patentably distinguishes over Sanders for the above additional reasons.

In view of the above, the subject rejection of claims 20-22, 28-29, and 32-35 is believed to have been overcome.

Claims 20-22, 28, 29 and 32-43 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Cool (EP 0 470 660 A1). This rejection is respectfully traversed.

Independent claims 20 and 36 each require that the superelastic material “having a transition temperature within the range of body temperature.” Independent claims 20 and 36 each also require that the correction force is generated “at body temperature without using external heating source.”

The cited portions of Cool do not teach the above claim features. In the cited portions of Cool, the correction rod consists of “a material with a shape memory, with an appurtenant transition temperature which is lower than the body temperature” (col. 1, ll. 6-8). Cool’s transition temperature is thus not “within the range of a body temperature” as recited in claims 20 and 36. Cool further teaches using the “pseudo-elastic behaviour of metals or metal alloys with shape memory, above the transition temperature” (col. 2, ll. 51-54; emphasis added). In the claimed invention, because the constant correction force is generated by the superelastic material at body temperature as recited claims 20 and 36, the superelastic behavior of the superelastic material occurs within the range of the transition temperature. Therefore, Cool’s correction operation differs from that of the claimed invention.

In view of the above, independent claims 20 and 36 each patentably distinguish over Cool. The subject rejection of claims 20-22, 28-29, and 32-45 is thus believed to have been overcome.

Claims 20-22, 28, 29, and 32-45 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Drewry (US 6,783,527). This rejection is respectfully traversed.

The cited portions of Drewry do not teach that the correction force is generated by a superelastic material "having a transition temperature within the range of body temperature," as recited in independent claims 20 and 36. Drewry is silent about its elongate member 80 having a transition temperature, much less "a transition temperature within the range of body temperature" as recited in independent claims 20 and 36. Therefore, independent claims 20 and 36 each patentably distinguish over Drewry.

In view of the above, the subject rejection of claims 20-22, 28-29, and 32-45 is believed to have been overcome.

Claims 36-45 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanders in view of Cool. This rejection is respectfully traversed.

As applicants submitted above, Sanders and Cool each lack, at least, the teaching that the correction force is generated by a superelastic material "having a transition temperature within the range of body temperature," as is recited in independent claim 36. Therefore even if Sanders and Cool are combined as suggested in the Office action, the combination still does not teach the above claim features recited in independent claim 36. The subject rejection is thus believed to have been overcome.

Claims 44 and 45 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cool in view of Sanders and Drewry. This rejection is respectfully traversed. Claims 44 and 45 depend from independent claim 36. Sanders and Drewry

are cited in the Office action with respect to the additional features in dependent claims 44 and 45 and do not cure the deficiencies of Cool. Accordingly, claims 44 and 45 are allowable for at least the same reasons that independent claim 36 is allowable. The subject rejection is thus believed to have been overcome.

Applicants have shown that claims 20-22, 28-29, and 32-45 are patentable over the cited art and hereby respectfully request that the rejections of these claims be withdrawn. Each of these pending claims in this application is thus believed to be in immediate condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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